

Remarks

Applicant has amended claims 1, 15, 21, 26-28, 30 and 32. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. (See e.g., pars. 4, 12 & Abstract; "prevent copying and/or alteration of printed hard copies of the document"). Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has rejected claims 1-4, 6, 7, 9, 12, 15-27, and 32 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,031,471 (Stefik et al.) in view of U.S. Application Serial No. 2003/2208494 (King et al.).

All of the pending claims recite a mark that has data unique to each page of the document (or, as claim 30 recites, an Optical Variable Device that contains data unique to each page of the file) and that "unauthorized copying and/or alteration of the printed digital file [or document] is prevented." The Examiner acknowledges that Stefik et al. "fails to teach a mark containing data unique to each page of the printed digital file," but submits that "King et al. teaches a mark containing data unique to each page of the printed digital file (unique barcode comprising the document and revision numbers, document digest and paging details is generated and attached to each page of the document image) (page 3, paragraph [0059])" (Office Action 6/10/09, p. 3). The Examiner then submits that it "would have been obvious . . . to have combined the teachings of Stefik with the teaching of King to embed the document with unique barcodes on each page of the document for authentication purposes and by using the embedded barcode to validate the verity of the digital file" (Id). Applicant respectfully disagrees.

King et al. teaches a "system and method for establishing and managing authenticated electronic documents . . . whereby the content, revision status and authenticating parties are stored, tracked, retrieved and validated on demand by permitted users."

(Abstract). One of the main objectives of the electronic document management system taught in King et al. is to provide means for "validating the verity of an electronically generated and authenticated document ... whereby both the contents and signatures may be matched to one another" (Par.5). Another main objective of King et al. is to "readily identify and track the changes made to such an electronic document during its lifecycle." (Id).

These objectives are achieved by applying a barcode to each page of the defined electronic document, and then applying a secure algorithm to the entire electronic document to generate a unique digital exchange key, which is stored in connection with the defined electronic document. (Par. 7). In use, the barcoded document is authenticated by the parties either by hand-signing a printed copy of the document or by applying a digital signature, and then the resultant document that is provided in electronic format is associated with the variable data originally inputted by a user by cross-referencing the digest component of the barcode to the stored digest associated with the defined electronic document. (Par. 9). Upon successful association, the system binds the electronic image of the signed document to the original input data, the bound electronic document is electronically stored and can be later accessed by authorized users to track document revisions and validate document contents and signatories (Id.). However, nowhere does King et al. teach that the barcode is printed (by a printer) on each page of the printed file in order to prevent unauthorized copying and/or alteration of documents, as recited in the present application. Rather, King et al. is solely directed toward tracking electronic changes.

In fact, the only scenario in which any kind of printing is mentioned in King et al. is when the electronic document needs to be hand-signed. In such case, a hard copy of the signed document is faxed to a server, which then scans the barcode from each page of the electronic copy of the faxed-in document and compares it to the barcodes stored in the database server. (Par. 60). While the presently claimed invention is directed toward the printing of unique information on each page of a document so as to

prevent unauthorized copying of the document, King et al. provides no such functionality. For example, the barcode referred to by the examiner could easily be copied because its function is related to the electronic copy. In fact, King et al. is not at all concerned with secure document printing, but rather is directed toward a system for creating, managing and authenticating documents in electronic form.

The Examiner asserts that it "would have been obvious" to combine the teachings of Stefik with the teaching of King to use the "embedded barcode to validate the verity of the digital file." Applicant respectfully submits that this has nothing to do with the presently claimed invention. Rather, as the claims recite, the system includes a "mark printed by said printer on each page of the printed digital file, said mark containing data unique to each page of the printed digital file." (Claim 1). Accordingly, the claims are directed toward printing a mark on the printed pages of the digital file, not toward putting a digital mark on a digital file to ensure verity of the digital file. The system provides a document security system that watermarks each page as it prints so as to indicate whether unauthorized printing, alteration or duplication of a document has occurred. The mark is provided such that it cannot be accurately copied or counterfeited. In contrast, if indeed the barcodes were actually printed by a printer on each page of a file in King et al., these barcodes could not prevent unauthorized printing, alteration or duplication of the document. Rather, the barcodes taught in King et al. are provided for the purpose of cross-referencing them with the barcodes stored on the server so that the signed document can be scanned in and stored as an electronic file on the server. However, the barcodes cannot prevent unauthorized copying of the printed page. Thus, combining the watermark of Stefik et al. with the barcode of King et al. would not aid in preventing unauthorized copying and/or alteration of a printed document because the barcode provided on each page of the printed and hand-signed document in King et al. could easily be copied to another page.

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could

have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976). This is not case here. The barcode taught in King et al. is not and, in fact, cannot be used to prevent "unauthorized copying and/or alteration of the printed digital file [or document]" as recited in all the claims. Accordingly, to reach the conclusion the examiner made in this case would mean that one would be using the barcode of King et al. or a completely different function that that for which it was created. Additionally, the barcode in King et al. would not prevent unauthorized copying and/or alteration as its function is purely for comparison with electronic data. Such a dramatic change in the function of King et al. cannot be considered obvious.

Additionally, it is well established that obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not identified all elements of the claims (namely, that "unauthorized copying and/or alteration of the printed digital file [or document] is prevented"), nor has the examiner provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention (in fact, the function of the barcode as taught in King et al. is completely ignored in favor of the function described in the presently pending application). Accordingly, Applicant respectfully requests the examiner to withdraw the rejections under 35 U.S.C. §103.

It is respectfully submitted that claims 1-28, 30 and 32, all of the claims remaining in the application, are in order for allowance and an early notice to that effect is respectfully requested.

Respectfully submitted,

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